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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,191	11/13/2001	Christoph Dobruskin	PHN 16,257A	4074
24737	7590	03/25/2004	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			CHERUBIN, YVESTE GILBERTE	
		ART UNIT		PAPER NUMBER
		3713		
DATE MAILED: 03/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/014,191	DOBRUSSKIN ET AL.
	Examiner Yveste G. Cherubin	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 November 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 4-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 4-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date 2. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

#### **DETAILED ACTION**

1. This action is in response to the US Application No. 10/014,191 filed November 13, 2001. A preliminary amendment was filed on November 13, 2001 canceling claims 1-3 and adding claims 4-15. Accordingly, claims 4-15 are pending.

#### ***Priority***

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

It is noted that per 37 CFR 1.78, such amendment to the first sentence or such application data sheet must be submitted "within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application", which time periods were already past at the time of mailing of this instant office action. It is noted that 37 CFR 1.78 sets forth the criteria for filing a petition to accept an unintentionally delayed claim under 35 USC 120, 121, or 365(c) for the benefit of a prior-filed application, and that one

such criterion sets forth that the reference required by 35 USC 120 to the prior-filed application, unless previously submitted, must be supplied.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,354,947. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant invention similarly teach a method and apparatus for a multimedia method and system for interaction between a screen-based host and various distributed and free-styled information containing items, comprising transmission means, signal means .... features as disclosed in the US Patent Nos. 6,354,947. Although the claims of the instant application are somewhat broader than the claims in the US Patent No. 6,354,947 the claim features "self-identifying said item in response to

proximity conditions between said host and said item" recited in the US Patent Nos. 6,354,947 would be an obvious omission.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 4, 8 are rejected under 35 U.S.C. 102(a) as being anticipated by Gilboa (WO No. 9,630188 A1 – of record).

With respect to claims 4, 8, Gilboa discloses a system comprising a computer (2) being read as a screen-based host system for interacting with items being presented as toy figures (10) which are selectively positioned on a game board, page 11, 2<sup>nd</sup> paragraph, pages 15-16, 5<sup>th</sup> paragraph. In reference to Figs. 9-18, when the board is in place, or at proximity conditions, Gilboa's system provides means such as three dimensional, non-line of sight wireless means, to transmit information to computer (2) or host, page 11, 3<sup>rd</sup> paragraph, pages 11-12, 5<sup>th</sup> paragraph, page 19, 3<sup>rd</sup> paragraph, lines 4-6. In reference to Figs 2A-2E, Gilboa discloses when one of the toy figures, a fox, on the game board, is sensed located in his home (14), a video sequence is displayed showing the fox at home, and appropriate audio message and/or interacting with the environment (associated service field), representing that toy figure is presented to the user in

response to the transmitted information of said fox being in his home, page 12, 3<sup>rd</sup> paragraph. See also page 12, 4<sup>th</sup>-6<sup>th</sup> paragraphs, page 13, 1<sup>st</sup>-3<sup>rd</sup> paragraph where various examples are given. Gilboa discloses identifying item in response to proximity conditions between host and item, page 11, 3<sup>rd</sup>-4<sup>th</sup> paragraphs, page 16, 3<sup>rd</sup> paragraph.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 5-7, 9-11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa in view of Sitrick (US Patent No. 5,830,065 – of record).

With respect to claims 5, 10, 13 Gilboa discloses the claimed invention as substantially as shown above. Gilboa fails to disclose enabling user to activate information processing related to associated service field. Sitrick teaches an entertainment system where he uses a camera to input information into an audiovisual presentation, 14:22-24. Sitrick further teaches that data or service related field, can be stored in memory for manipulation (activation), 31:50-55, abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the cited above feature as taught by Sitrick

into the Gilboa type system for editing purposes. With respect to claims 6, 11, 14 Sitrick discloses providing a storage for storing data or service related field, 13:44-47, 14, 28-39, therefore transmitting to item host-generated results related to associated service field would be obvious. With respect to claims 7, 9, 15 Sitrick discloses using icons to represent visual and sound images being integrated into predetermined stored audiovisual presentation, 13:1-5.

b. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa.

With respect to claim 12, it recites the limitations of claims 4 or 8 with the exception of identifying host to item in response to proximity conditions between said host and said item. Gilboa discloses the claimed invention as substantially as described above. Gilboa further discloses identifying items in response to proximity conditions between host and item. However, Gilboa fails to disclose identifying host to item in response to proximity conditions between said host and said item. Such feature would have been a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the identification process in the reverse direction for the same reason given in Gilboa, which is transmitting and detecting signals between host and item.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA (Applicant's Admitted Prior Art – referred to as AAPA herein after) and Redford (US Patent No. 5,788,507 – of record).

With respect to claims 4, 6, 8-9, 12, 14, AAPA discloses a game system comprising a screen-based host, and I/O facilities, page 1, lines 2-6. AAPA meet all the claimed limitations with the exception of transmitting information to said host in response to proximity conditions between host and item, and signaling to the user an associated service field. AAPA fails to disclose the steps of transmitting information to host in response to proximity conditions between host and item, and signaling to user an associated service field in response to transmitted information. Redford discloses the steps of transmitting user service field in response to transmitted information, see Fig 4A, 2:56-65, 14:33-44 and signaling to the user an associated service field, 3:1-10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the step of transmitting and signaling as taught by Redford onto the game system of AAPA in order to obtain a multimedia communication system which provides means for interactive communication. The step of identifying

items in response to proximity conditions would be obvious. Note that since data is being transmitted/exchanged between host and items, that would inherently mean that identification was established. With respect to claims 7, 11, 15, an icon, by definition is a small image displayed on a screen to represent an object that can be manipulated/activated. Iconizing means is extremely old and well known in the art. The use of icons depends on the suitable application and the intended use of the product. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the iconizing means in the AAPA in view of Redford type system in order to allow the user to control certain computer actions without having to remember commands or type them on the computer keyboard. It's well known that icons are a significant factor in the user-friendliness of graphical user interfaces. With respect to claims 5, 10, 13, as noted above, icons are objects that can be manipulated/activated. Therefore, activating information processing operations related to associated field of service would have been obvious.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. GB No. 2,237,514 to Taylor, which teaches computer board game.
  - b. GB 2,103,943 to Blenkinsop, which teaches electronic board game.
  - c. US Patent No. 5,937,081 to O'Brill et al., which teaches image composition system and method of using the same.

d. US Patent No. 5,188,368 to Ryan, which teaches electronic game apparatus.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, T. Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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